

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-26 and 29.

The following claims are *independent*: 1, 23 and 24.

The following claims have previously been *cancelled* without prejudice or disclaimer: 27 and 28.

Please *amend* claims 1, 6, 23 and 24 and please *add* new claim 29; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that the new claim and claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 103

The rejections of claims 1, 2, 4-12, 15-19, 22 and 25-26 under 35 U.S.C. § 103(a) as set out in previous Office Actions have been maintained, allegedly holding these claims as being unpatentable over Snow et al., US Patent No. 6,098,066 (hereinafter “Snow”), and in further

view of Anderson et al., US Patent No. 6,510,434 (hereinafter “Anderson”). The rejections of claims 3, 13, 20 and 21 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Snow, in view of Anderson, and in further view of Husick et al., US Patent No. 5,717,914 (hereinafter “Husick) and of claim 23 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Snow, in view of Anderson and in further view of Beaulieu et al., U.S. Patent No. 5,502,637 (hereinafter “Beaulieu”) have also been maintained.

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, “the obviousness or nonobviousness of the subject matter [be] determined,” and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

reference(s);
(C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art*.” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A) and (B)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in amended independent claim 1:

A processor-implemented method of facilitating access to documents, comprising:

...

generating by a processor at least one relationship between the content selection tags in the set in accordance with a pre-

determined rule associated with the at least one hierarchical domain;

providing the content reader an indication of a document in accordance with the hierarchical tag domain and the set of content selection tags having the at least one relationship ...

The Office Action asserts the previously pending claimed elements are shown in Snow and Anderson. Although Applicant disagrees and respectfully traverses the rejections, Applicant submits that the applied references of Snow and Anderson, taken alone or in combination, do not discuss or render obvious the claimed elements as amended.

Instead of discussing the claimed elements as amended, Applicant submits that Snow discusses *relying on the user-provided search terms for indiscriminate searching of all directories*. For example, Applicant notes that Snow discusses, "... a user query may comprise one or more search terms ..." (Snow, col. 7, lines 60-61) and that the same "... search terms are compared to each of the relevant document vectors created by the document indexing of the document directory hierarchy ..." (Snow, col. 8, lines 35-39). Applicant further notes that Snow discusses the relevant documents vectors are "... the document vectors within the zero node [root directory] index ..." (Snow, col. 8, lines 39-41).

Accordingly, Applicant submits that Snow's search based on discrete terms does not discuss or render obvious the claimed "... generating at least one relationship between the content selection tags in the set in accordance with a predetermined rule associated with the at least one hierarchical domain ...," let alone the claimed "... providing the content reader an indication of a document in accordance with the hierarchical tag domain and the set of content selection tags having the at least one relationship ..."

Furthermore, Applicant submits Anderson fails to remedy the deficiencies in Snow. in contrast to the claimed elements as amended, Anderson discusses *a method that uses a key to locate records that include all the XML tags corresponding to the search*. For example, Applicant notes Anderson discusses that “[w]hen a search request is received, a set of tags that correspond to the request are identified.” (Anderson, col. 3, lines 2-5). Anderson further discusses that the identified “... set of tags are compiled as a key and is used to search the database to locate records that include the set of tags.” (Anderson, col. 3, lines 5-7).

However, Applicant submits that Anderson’s searching records via a “key” compiled from a set of tags is different from the claimed “... generating at least one relationship between the content selection tags in the set in accordance with a predetermined rule associated with the at least one hierarchical domain ...” and the claimed “... providing the content reader an indication of a document in accordance with the hierarchical tag domain and the set of content selection tags having the at least one relationship ...” as explicitly recited in amended independent claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection and allowance of the claim, as Applicant submits that for at least the foregoing reasons, amended claim 1 is neither anticipated nor rendered obvious by the applied references taken alone or in combination.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing

indications of specific, alleged correspondences between claim elements and cited portions of the applied reference; more specifically, Applicant respectfully requests additional clarification as to how and specifically why the Examiner believes Snow and/or Anderson discusses or renders obvious the noted claim elements as recited in amended independent claim 1.

Although of different scope than amended independent claim 1, Applicant submits amended independent claim 23 is also patentable over the applied references, taken alone or in combination. For example, amended independent claim 23 recites, *inter alia*:

A processor-implemented method of facilitating access to investment research documents, comprising:

...

defining a first relationship between content selection tags included in the first content selection tag set in accordance with a predetermined rule associated with the at least one hierarchical tag domain association relating to the first content selection tag set;

defining a second relationship between content selection tags in the second content selection tag set in accordance with a predetermined rule associated with the at least one hierarchical tag domain association relating to the second content selection tag set;

identifying by a processor a first investment research document in accordance with the first content selection tag set and the first relationship;

identifying by the processor a second investment research document in accordance with the second content selection tag set and the second relationship

Applicant submits that at least these claim elements are not discussed or rendered obvious by the applied references for at least the reasons discussed above with regard to

amended independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection and allowance of the claim.

Although of different scope than amended independent claims 1 or 23, Applicant submits amended independent claim 24 is also patentable over the applied references, taken alone or in combination. For example, amended independent claim 24 recites, *inter alia*:

An apparatus, comprising:

...

generate at least one relationship between the content selection tags in the set in accordance with a predetermined rule associated with the at least one hierarchical tag domain;

provide the content reader an indication of a document in accordance with the hierarchical tag domain and the set of content selection tags having the at least one relationship

Applicant submits that at least these claim elements are not discussed or rendered obvious by the applied references for at least the reasons discussed above with regard to amended independent claim 1 and 23. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection and allowance of the claim.

Furthermore, claims 2, 4-12, 15-19, 22 and 25-26, and newly added claim 29 which depend directly or indirectly from amended independent claims 1 and 24 are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above with regard to the claims from which they depend. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of the claims.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office

Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-26 and 29, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-444. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-444.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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Dated: July 16, 2010

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